

REMARKS**Summary of the Office Action**

The amendment filed on May 2, 2005 stands objected to under 35 U.S.C. § 132(a) because it allegedly introduces new matter into the disclosure.

Claim 1 stands rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the written description requirement.

Claim 1 stands rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite.

Claims 1-3, 5-7, 12-14, 19, 22, 25, 27, 28 and 30 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Hashimoto (EP 938,091) (hereinafter “Hashimoto”).

Summary of the Response to the Office Action

Applicants have amended claims 1, 5, 12, 19, and 22 to differently describe embodiments of the disclosure of the instant application’s specification and/or to improve the form of the claims. Accordingly, claims 1-3, 5-7, 12-14, 19, 22, 25, 27, 28 and 30 remain pending for consideration.

Objection under 35 U.S.C. § 132(a) and Rejection under 35 U.S.C. § 112, First Paragraph

The amendment filed on May 2, 2005 stands objected to under 35 U.S.C. § 132(a) because it allegedly introduces new matter into the disclosure. Claim 1 stands rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the written description requirement.

The Examiner alleges that the following limitation is not supported by the original disclosure: "wherein in the recording process, the scramble system applying step applies only one scramble system to the descrambled information signal, and the only one scramble system is

a scramble system which is applied to the case where recording information with the second copy control information is recorded onto the recording medium".

Applicants respectfully traverse such an assertion for at least the following reasons.

Applicants respectfully submit that the "only one scramble system" is described as "the system B" in the specification. Further, the second copy control information is described as "No More Copy" in the specification. The second copy control information is defined in the last two lines on page 3 of Amendment filed on May 2, 2005, "second copy control information indicating prohibition of copying the information signal after the information signal is copied once". In the specification, the system B is applied to the case where recording information with the copy control information "No More Copy " is recorded onto the recording medium.

Detailed explanations of such features are found throughout the specification of the instant application. For example, see line 19 on page 24 through line 3 on page 25 of the specification. The specification clearly describes that the signal inputted to the recording apparatus 2 is scrambled by the system B and this is followed by the copy control information being updated to "No More Copy" information.

In addition, at line 23 on page 27 through line 7 on page 28 of the instant application's specification, clear description is provided that the recording apparatus 4 scrambles the signal by the system B, and then the copy control information is updated to "No More Copy" information.

As a result, Applicants respectfully submit that the original disclosure supports claim 1's feature of "wherein in the recording process, the scramble system applying step applies only one scramble system to the descrambled information signal, and the only one scramble system is a scramble system which is applied to the case where recording information with the second copy

control information is recorded onto the recording medium." Accordingly, withdrawal of the objection under 35 U.S.C. § 132(a) is respectfully requested.

With regard to the rejection of claim 1 under 35 U.S.C. § 112, first paragraph, Applicants respectfully submit that, as explained above, the "wherein in the recording process, the scramble system applying step applies only one scramble system to the descrambled information signal, and the only one scramble system is a scramble system which is applied to the case where recording information with the second copy control information is recorded onto the recording medium" is clearly supported by the original disclosure. Therefore, the rejection under 35 U.S.C. § 112, first paragraph, of claim 1 should be withdrawn.

Rejection under 35 U.S.C. § 112, Second Paragraph

Claim 1 stands rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite. With regard to the rejection of claim 1 under 35 U.S.C. § 112, second paragraph, Applicants have amended the claims to differently describe embodiments of the disclosure of the instant application and/or to improve the form of the claims. In particular, claim 1 has been amended to recite that "the descramble system applying step applies one type of the descramble system to a scramble system of the information signal with the second copy control information and applies the other types of the descramble systems to scramble systems of the information signal with the first copy control information."

In addition, Applicants have newly-amended the preamble of claim 1 to describe "[a] copyright protecting method of descrambling and scrambling an information signal inputted via an input path and outputting it via an output path, the input path and the output path included in a recording process and a reproducing process..." As a result, Applicants respectfully submit that

the recording process and the reproducing process are described in the claim as having a descramble system.

Accordingly, Applicants have amended claim 1, as well as claims 5, 12, 19 and 22, in response to the Examiner's comments at pages 3-4 of the Office Action with regard to these rejections. Applicants respectfully submit that the claims, as newly-amended, fully comply with the requirements of 35 U.S.C. § 112, second paragraph. Accordingly, Applicants respectfully request that the rejection under 35 U.S.C. § 112, second paragraph be withdrawn.

Rejection under 35 U.S.C. § 102(b)

Claims 1-3, 5-7, 12-14, 19, 22, 25, 27, 28 and 30 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Hashimoto. Applicants have amended claims 1, 5, 12, 19 and 22 to differently describe embodiments of the disclosure of the instant application's specification. To the extent that these rejections might be deemed to apply to the claims as newly-amended, they are respectfully traversed for at least the following reasons.

Applicants respectfully submit that Hashimoto discloses copy control information indicating "free," "once," and "prohibited". Further, Hashimoto goes on to disclose an encryption mode indicator (EMI) indicating: mode A for copy-prohibited data, mode B for copy once data, and free for non-encrypted copy free contents data.

However, Applicants respectfully submit that in Hashimoto, a common EMI is used in both the reproduction mode and the recording mode. See, for example, Figs. 5 and 11 of Hashimoto, and their corresponding explanations in the description. Applicants note that Hashimoto utilizes such a common EMI because its disclosed system is of a simple nature in that all devices are connected serially, as illustrated and described with regard to Fig. 1.

In contrast, Applicants respectfully submit that the arrangements of embodiments of the disclosure of the instant application are very complex, especially as compared to the disclosure of Hashimoto. See, for example, Fig. 1 of the instant application, which includes a wide variety of possible system paths. More particularly, Applicants respectfully submit that, in embodiments of the instant application, to prevent contents from being illegally copied and reproduced, a descramble system in a reproducing apparatus is different from a descramble system in a recording apparatus. Even further, scramble systems in a reproducing apparatus are different from those in a recording apparatus. These assertions were included in the previous response filed on May 2, 2005 and are still applicable. At page 2, section 2 of the Final Office Action, the Examiner alleges that Applicants did not specifically point out how the language of the claims patentably distinguishes from the references.

Applicants respectfully submit that in claim 1, these features are described, for example, as, "*wherein the scramble system in the recording process is different from that in the reproducing process, and descramble system in the recording process is different from that in the reproducing process.*" In the description, the recording apparatuses have descramble systems of type C or type E and a scramble system of type B. Further, the reproducing apparatus has descramble systems of type A or type B and scramble systems of type D or type E.

Even further, claim 1, as newly-amended, describes "*wherein the descramble system applying step applies one type of the descramble system to a scramble system of the information signal with the second copy control information and applies the other types of the descramble systems to scramble systems of the information signal with the first copy control information.*"

In the description, one type of the disclosed descramble systems is applied to a scramble system (type B) with the second copy control information (No more copy). The other types of

the descramble systems are applied to scramble systems (types A, C, E) of the information with the first copy control information (Copy Once).

Moreover, claim 1 goes on to describe "*wherein in the recording process, the scramble system applying step applies only one scramble system to the descrambled information signal, and the only one scramble system is a scramble system which is applied to the case where recording information with the second copy control information is recorded onto the recording medium.*"

In the description, the recording apparatuses 2, 4 scramble the information by type B, and the copy control information is updated to "No More Copy".

In addition, claim 1 even further describes "*wherein, in the reproducing process, the scramble system applying step applies three different kinds of scramble systems to the information with the first copy control information recorded on the recording medium, to the information with the second copy information recorded on the recording medium, and to the information signal with the first copy control information outputted from a receiving apparatus*".

In the description, the reproducing apparatus 3 scrambles the information with "Copy Once" by type E (path C1-E1), type D (path B1-E1), and type C (path A1).

As a result of this novel combination of features, as specifically described in the claims, Applicants respectfully submit that it is possible to set proper combinations of scramble systems, descramble systems, and copy control information, respectively, in each of a recording apparatus and a reproducing apparatus. By this configuration, Applicants respectfully submit that it is possible to prevent the contents from being illegally copied and reproduced in a way that is neither shown nor suggested by the disclosure of Hashimoto.

For example, assuming that a scramble system for copy control information of the "no more copy" type is set as a type "B" in all apparatuses, Applicants respectfully submit that it is impossible to prevent the contents of a recording medium 75 described in Fig. 1 of the instant application from being reproduced. If a medium 71 has copy control information of "no more copy" type and is scrambled by the type "B", a reproduction apparatus 3 outputs the contents of the medium 71 with copy control information of the "no more type" and scramble type "B." Please see, for example, path E1 in Fig. 1 of the instant application.

Applicants respectfully submit that a recording apparatus 4 does not record contents on a recording medium 73. On the other hand, if an unauthorized reproducing apparatus 6 reads the contents of the medium 71 with copy control information of the "no more copy" type and scrambled type "B" (path B2) and outputs the contents to an unauthorized recording apparatus 7, please see, for example, path F2 in Fig. 1 of the instant application, the unauthorized recording apparatus 7 illegally records the contents on the recording medium 75 with copy control information of the "no more copy" type and scrambled type "B." Therefore, Applicants respectfully submit that the contents of the recording medium 75 can be reproduced by the reproduction apparatus 3.

However, in embodiments of the disclosure of the instant application, Applicants respectfully submit that the recording apparatus 2 and recording apparatus 4 have a scramble system type "B" as specifically described in claim 1 as "*wherein in the recording process, the scramble system applying step applies only one scramble system to the descrambled information signal, and the only one scramble system is a scramble system which is applied to the case where recording information with the second copy control information is recorded onto the recording medium.*" Then, Applicants respectfully submit that the reproducing apparatus 3 has a scramble

system of type "D" for "No more copy" and a descramble system for the scramble system type "B" as specifically described in claim 1 as "*wherein, in the reproducing process, the scramble system applying step applies three different kinds of scramble systems to the information with the first copy control information recorded on the recording medium, to the information with the second copy information recorded on the recording medium, and to the information signal with the first copy control information outputted from a receiving apparatus*".

Applicants respectfully submit that therefore, the contents of the medium 71 with copy control information of the "no more copy" type and scramble type "B" are descrambled by the reproducing apparatus 3. Further, the reproducing apparatus 3 scrambles the descrambled contents by type "D".

However, Applicants respectfully submit that the recording apparatus 4 does not have the descramble system of type "D", and the contents outputted from the reproducing apparatus 3 is not recorded on the recording medium 73. On the other hand, the unauthorized reproduction apparatus 6 reads the contents of the recording medium 71 (path B2 in Fig. 1 of the instant application), and the outputs the contents with illegally rewritten copy control information "copy once" and scrambled type "D" (path F2). Then, the unauthorized recording apparatus 4 forcefully records the contents with copy control information "copy once" and scrambled type "D". However, since the reproducing apparatus 3 does not have the descramble system for the scramble system type "D", Applicants respectfully submit that illegally copied contents of the recording medium 75 cannot be reproduced by the reproducing apparatus 3.

Accordingly, Applicants respectfully submit that Hashimoto does not teach or suggest each of the features described in the combination of newly-amended independent claim 1. Moreover, newly-amended independent claims 5, 12, 19 and 22 are also not anticipated by

Hashimoto for similar reasons as independent claim 1. Even further, Applicants respectfully submit Hashimoto merely discloses a way to prohibit contents from being illegally recorded, without teaching or suggesting, to any extent, features relating to the prohibition of reproducing of illegally copied contents, in the manner described in each of independent claims 25 and 28, for example.

Accordingly, Applicants respectfully assert that the rejections under 35 U.S.C. § 102(b) should be withdrawn because Hashimoto does not teach, or even suggest, each feature of independent claims 1, 5, 12, 19, 22, 25 and 28 of the instant application. As pointed out in MPEP § 2131, "[t]o anticipate a claim, the reference must teach every element of the claim." Thus, "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. Verdegaal Bros. v. Union Oil Co. Of California, 2 USPQ 2d 1051, 1053 (Fed. Cir. 1987)." Furthermore, Applicants respectfully assert that the dependent claims are allowable at least because of their dependence from claims 1, 5, 12, 19, 22, 25 or 28, and the reasons set forth above.

Request for Acknowledgement of Replacement Drawing Sheets

Applicants filed a Submission of Replacement Drawing Sheets on May 2, 2005. In the subsequent Office Action dated June 9, 2005, the Examiner accepted the drawings filed on May 9, 2001, but did not refer to the replacement drawings filed on May 2, 2005. Acknowledgement and acceptance of the replacement drawings filed on May 2, 2005 is respectfully requested.

CONCLUSION

In view of the foregoing, Applicants respectfully request the entry of the amendments to place the application in clear condition for allowance or, alternatively, in better form for appeal. Should the Examiner feel that there are any issues outstanding after consideration of this response, the Examiner is invited to contact Applicants' undersigned representative to expedite prosecution.

EXCEPT for issue fees payable under 37 C.F.R. § 1.18, the Commissioner is hereby authorized by this paper to charge any additional fees during the entire pendency of this application including fees due under 37 C.F.R. § 1.16 and 1.17 which may be required, including any required extension of time fees, or credit any overpayment to Deposit Account No. 50-0573. This paragraph is intended to be a **CONSTRUCTIVE PETITION FOR EXTENSION OF TIME** in accordance with 37 C.F.R. § 1.136(a)(3).

Respectfully submitted,

DRINKER BIDDLE & REATH LLP

Dated: December 21, 2005

By:



Paul A. Fournier
Reg. No. 41,023

Customer No. 055694

DRINKER BIDDLE & REATH LLP
1500 K Street, N.W., Suite 1100
Washington, DC 20005-1209
Tel.: (202) 842-8800
Fax: (202) 842-8465